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PATTON BOGGS, L.L.P. 2001 ROSS AVENUE, SUITE 3000 DALLAS, TX 75201			EXAMINER CHANKONG, DOHM	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/922,348	Applicant(s) BORGER ET AL.	
	Examiner Dohm Chankong	Art Unit 2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1> This action is in response to Applicant's remarks filed 3.6.2007. Claims 1-62 are presented for further examination.

2> This is a non-final rejection.

Response to Arguments

3> Applicant's arguments with respect to claims 1-56 have been considered but are moot in view of the new ground(s) of rejection. Applicant characterizes Dames as nothing more than translating web content to audio content. Applicant's characterization ignores the fact that Dames clearly discloses inserting text or content into text prior to transcoding the text to speech [0027, 0040]. Thus, the only difference between Dames and Applicant's claimed invention is while Dames discloses inserting text into requested content, the claimed invention claims inserting text advertisements. The new prior art rejection addresses this minor difference.

4> Applicant's arguments with respect to claims 57-62 have been considered but are not persuasive. Applicant reiterates the argument that Logan teaches transferring text content to the client where it is transcoded into speech. This argument has no force with respect to claim 57 because *Logan is simply relied upon to teach storing information associated with delivery of the advertisement*. Logan is not being relied upon to teach translation of text to audio or that advertisements can be stored.

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This is because Wu teaches all other limitations including the fact that the content and inserted advertisement are first transcoded into audio format before delivering the new content to the client [Figure 3 : audio ad being delivered to the client | 0032 where : the advertisement is delivered "in band" with the requested content]. Wu is only being modified to include Logan's teaching of storing information associated with delivery of the advertisement and no more. Simply put, Logan does not teach away from storing information associated with delivery of the advertisement. Based on the foregoing, Applicant's arguments are not persuasive. The rejections of claims 57-62 under Wu in view of Logan are therefore maintained.

It should be noted that a major difference between claim 57 and other independent claims is that claim 57 does not require converting the requested web content from text to an audio format. Claim 57 merely requires inserting an advertisement into requested content. Claim 57 does not even expressly require that the advertisement be transcoded; it is merely implied by the limitation that a notification is received when the advertisement has been delivered in audio format.

Priority

5> The priority date of Applicant's application is August 3, 2001 because the instant application is not entitled to the priority date of its provisional application, 60/224,152. The effective filing date [of an application] is the filing date of the provisional application for any claims which are fully supported under the first paragraph of 35 U.S.C. 112 by the provisional application. MPEP §706.02(V)(D). That is, the instant application is only entitled to the

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priority date of the provisional application if the provisional application fully supports the claims under the written description and enablement requirements of 35 U.S.C §112.

Here, the provisional application fails to provide a supporting written description and also would not enable one of ordinary skill in the art to make and use the invention. The provisional application consists of 3 pages of generic description for an invention that combines voice portal and advertising methodology. The primary focus of the provisional is on providing interactive advertisements; the provisional discusses in broad strokes the purpose of the invention and various features but lacks any descriptive material as to specific elements and functionality as seen in the claims of the instant application. The provisional application's disclosure does not provide adequate written description of the claimed limitations nor would it have enabled one of ordinary skill in the art to make and use the claimed invention.

For example, claim 1 discusses a text-to-speech transcoder, retrieving advertisements from a server, inserting the advertisements within requested web content and then forwarding the now combined content and advertisement to the transcoder for conversion to audio format. There is nothing in the provisional application that could be construed as supporting these features; there is no discussion of a transcoder, an advertisement server that stores advertisements in text-based format or converting the content and advertisements from text into an audio format.

Because each claim limitation is not supported by the disclosure of the provisional application, the instant application is not entitled to the priority date of the provisional. Instead, the instant application the priority date of the instant application is the filing date of

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the application, August 3, 2001. Therefore, the Wu reference qualifies as prior art against the instant application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6> Claims 1-56 are rejected under 35 U.S.C § 103(a) as being unpatentable over Dames et al, U.S Patent Publication No. 2002/0129067 ["Dames"], in view of Funk et al, U.S Patent No. 5,937,162 ["Funk"], in further view of Logan et al, U.S Patent. 6,199,076 ["Logan"].

7> As to claim 1, Dames discloses a computer system configured to integrate advertising within Web content requested by users, comprising:

a text-to-speech transcoder [0011, 0028], comprising:

means for converting Web content from a text-based format to an audio

format [0011, 0026, 0040]; and

means for serving Web content in an audio format to a user client device via telephone link with the user client device [0007]; and

a Web server that hosts Web content in a text-based format [0009, 0010 : server

implied because Dames discloses HTML formatted content], comprising:

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means, responsive to a user request via the client device for Web content, for retrieving related content [0027, 0040 where: Dames discloses responsive to a user request, related content is retrieved to be placed into the template in place of the content markers];

means for inserting the retrieved advertisement within the user requested Web content [0040 : inserting text related to requested content (weather)]; and

means for forwarding the user requested Web content and related content to the text-to-speech transcoder for conversion to an audio format and subsequent delivery to the user client device [0051 : "end user can listen to the content over a cellular telephone connection"].

Dames does not expressly disclose an advertisement server or inserting advertisements into the user requested content.

8> In the same field of invention, Funk is directed to a system that delivers requested content to users [column 4 «lines 12-24»]. Funk expressly discloses inserting advertisements within the Web content [column 9 «lines 49-61» | column 10 «lines 47-53»]. After insertion of the advertisements within the requested content, the requested content and the inserted advertisement can then be transferred to a voice mail service that transcodes the new content from text to speech [Figure 1 | Figure 2 «item 220» | Figure 7 | column 6 «lines 12-24 and 43-52» where : Funk does not expressly disclose that the insertion of the advertisements occurs before transcoding the content but this functionality is reasonably inferred from the disclosure. For example, Funk discloses that the insertion takes place at composition

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processor 706 which is a component of the service processing system 104. This newly combined content is then transmitted to the voice mail service where the content is translated].

Thus it would have been obvious to one of ordinary skill in the art to modify Dames to include Funk's advertisement insertion functionality. As noted, Dames does disclose retrieving user request related textual content and then inserting the textual content into the requested content. Dames already discloses inserting related content, such as sports scores, weather and financial news [0027, 0040]. Funk would improve upon Dames system by allowing for advertisements that are targeted to the user or even based on the requested content being delivered to the user [column 10 «lines 47-52»].

9> Funk does not expressly disclose an advertisement server but does disclose that the service processing system (where the advertisement insertion takes place) has access to source information databases that host information in a text-based format [column 9 «lines 49-61» | column 10 «lines 58-64»]. Further, Logan expressly discloses an advertisement server that host advertisements in a text-based format [Figure 1 «item 135» | column 5 «lines 47-59»].

Logan discloses that the benefits of advertisements in a text-to-audio system include providing a means of defraying subscription costs and enabling companies to provide targeted advertising [column 44-67»]. It would have been obvious to one of ordinary skill in the art to incorporate an advertisement server as taught by Funk and Logan into Dames to have a database that stores general or targeted advertisements into requested content. It

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should be noted that Logan is only being relied upon to teach an advertisement server and not being relied upon to teach insertion of advertisements into web content.

10> As to claim 2, Dames discloses selecting related content for insertion within user-requested web content in response to a user request for web content [0040].

Dames does not expressly disclose an advertisement server.

11> Logan discloses utilizing an advertisement server [Figure 1 «item 130»]. It would have been obvious to one of ordinary skill in the art to have implemented Logan's advertisement server into Dames in order to incorporate advertisement functionality into Dames' text-to-speech system. Benefits from a combination include providing a means of defraying subscription costs and enabling companies to provide targeted advertising [Logan, column 44-67»]. See also the rejection of claim 1.

12> As to claim 3, Dames discloses retrieving content having a format and size compatible with user-requested Web content when the Web content is converted to an audio format [0040]. Dames does not disclose advertisements.

Funk discloses inserting advertisements into requested content based on user information and information already in the content [column 10 «lines 47-52»]. Further, Logan discloses wherein means for selecting advertisements for insert within user-requested Web content comprises means for retrieving advertisements having a format and size compatible with user-requested Web content when the web content is converted to an audio

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format [Figure 4 | column 18 «lines 21-45» | column 25 lines 35-50 where : Logan discloses the advertisements are inserted into a schedule table with the regular content, the advertisements in audio format like the requested content. The table ensures that the advertisements are of “compatible” size with the content as well].

Dames, Funk and Logan are concerned with providing content that will be compatible with the user-requested content [see Dames, 0011]. It would have been obvious to one of ordinary skill in the art to incorporate Logan’s advertisement scheduling functionality into Dames’ system to insure that advertisements (content) inserted into content are compatible with the web content.

13> As to claim 4, Dames does not disclose the advertisement having a predetermined time length.

14> Logan discloses retrieving an advertisement having a predetermined time length when delivered in an audio format [Figure 4 | column 18 «lines 21-45» | column 23 «lines 40-45» | column 24 «lines 9-31» | column 25 lines 35-50 | column 34 «lines 24-44» where : the advertisement is defined as a segment of content]. It would have been obvious to one of ordinary skill in the art to incorporate Logan’s advertisement segments of predetermined length into Dames’ system to provide related content that is consistent with the user-requested content.

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15> As to claim 5, Dames discloses the text-based format comprising VXML format [0026].

16> As to claim 6, Dames does not disclose an advertisement server.

17> Logan discloses an advertisement server further comprising means for storing information associated with serving an advertisement to a user [Figure 1 «item 130» | column 5 «lines 47-59» where : item 130 corresponds to an advertising server]. It would have been obvious to one of ordinary skill in the art to incorporate Logan's advertising server into Dames to provide a central location for storing advertisements. Such an implementation is desirable for allowing quicker and more efficient access to advertisements.

18> As to claim 7, Dames does not expressly disclose means for determining if a user listened to an advertisement in its entirety.

19> Logan discloses means for determining if a user listened to an advertisement in its entirety [column 10 «lines 21-29» | column 28 «lines 24-41» : "start and end times"]. It would have been obvious to incorporate Logan's billing techniques into Dames to insure that subscriber billing is accurate and based on the viewing of advertisements of the users [see Logan, column 28 «lines 42-65»].

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20> As to claim 8, Dames does not expressly disclose means for determining how many times a user listened to an advertisement.

21> Logan discloses means for determining how many times a user listened to an advertisement [column 28 «lines 6-65»]. It would have been obvious to incorporate Logan's billing techniques into Dames to insure that subscriber billing is accurate and based on the viewing of advertisements of the users [see Logan, column 28 «lines 42-65»].

22> As to claim 9, as it substantially has the limitations of claim 1, see the rejection of claim 1, above, under Jimenez and Logan. Claim 9 differs primarily because it is directed towards interactive advertisements. Logan teaches interactive advertisements [column 27 «lines Logan discloses means for notifying the advertisement server of user interaction with an advertisement [column 28 «lines 6-65»]. It would have been obvious to incorporate Logan's billing and advertisement functionality into Dames to insure that subscriber billing is accurate and based on the viewing of advertisements of the users [see Logan, column 28 «lines 42-65»].

23> As to claim 10, Dames does not teach the claimed limitations.

24> Logan teaches:

means for retrieving additional information associated with an advertisement in

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response to user interaction with the advertisement [column 10 «lines 44-67» | column 31 «lines 14-62»]; and

means for delivering the additional information to the user client device in an audio format [column 31 «lines 14-62» where : hyperlinks retrieve further content. Logan teaches throughout his disclosure that his content includes text and audio format content].

It would have been obvious to one of ordinary skill in the art to incorporate Logan's interactive advertisements into Dames to enable additional content that is relevant to the user's interests to be retrieved, ensuring targeted advertisements and information.

25> As to claim 11, Dames does not teach the claimed limitations.

26> Logan teaches :

means for recognizing one or more key words spoken by the user during delivery of an advertisement [column 31 «lines 48-62» : "voice command response"]; and

means for redirecting the user client device to additional audio content associated with the advertisement in response to recognition of one or more key words spoken by the user [column 31 «lines 14-62» where : hyperlinks retrieve further content. Logan teaches throughout his disclosure that his content includes text and audio format content].

It would have been obvious to one of ordinary skill in the art to incorporate Logan's interactive advertisements into Dames to enable additional content that is relevant to the user's interests to be retrieved, ensuring targeted advertisements and information.

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27> As to claim 12, Dames does not disclose means for retrieving additional information from the advertisement server.

28> Logan discloses means for retrieving additional information in response to user interaction comprises means for retrieving additional information from the advertisement server [column 3 «lines 22-31» | column 17 «lines 18-27»]. It would have been obvious to one of ordinary skill in the art to modify Dames with Logan's advertisement interaction functionality. It would have been obvious to one of ordinary skill in the art to incorporate Logan's interactive advertisements into Jimenez to enable additional content that is relevant to the user's interests to be retrieved, ensuring targeted advertisements and information.

29> As to claims 13 and 31, as they do not teach or further define over the previously claimed limitations, they are similarly rejected for at least the same reasons set forth for claim 2.

30> As to claims 14, 15, 21, 22, 32, 33, 40, 41, 50 and 51, as they do not teach or further define over the previously claimed limitations, they are similarly rejected for at least the same reasons set forth for claims 3 and 4.

31> As to claims 16, 23, 34, 42 and 52, as they do not teach or further define over the previously claimed limitations, they are similarly rejected for at least the same reasons set forth for claim 5.

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32> As to claims 17-19, 24-26, 35-38, 43-45, and 53-56, as they do not teach or further define over the previously claimed limitations, they are similarly rejected for at least the same reasons set forth for claims 6-8.

33> As to claims 20, 27, 39 and 46, as they do not as it does not teach or further define over the previously claimed limitations, they are similarly rejected for at least the reasons set forth for claims 1 and 9.

34> As to claims 28 and 47, as they do not teach or further define over the previously claimed limitations, they are similarly rejected for at least the reasons set forth for claim 10.

35> As to claims 29 and 48, as they do not teach or further define over the previously claimed limitations, they are similarly rejected for at least the same reasons set forth for claim 11.

36> As to claims 30 and 49, as the y do not teach or further define over the previously claimed limitations, they are similarly rejected for at least the same reasons set forth for claim 12.

37> Claim 57-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu, U.S Patent Application No. 2003/0212759, in further view of Logan.

38> In regards to claim 57, Wu discloses a advertising server (figure 4-#54) that integrates interactive advertising within Web content requested by users ([0027] lines 12-15, [0032] lines 1-6), comprising:

means for selecting an advertisement for insertion within Web content requested by a user via a client device [0027, 0032] in communication with a Web server (figure 4), wherein the advertisement has a text-based format ([0025] lines 29-31) and is configured to be interactive when converted to an audio format;

means for forwarding the selected advertisement to the Web server for insertion within the Web content requested by the user [0020, 0032 : delivered "in-band" with the requested content]; and

means for receiving notification([0030], [0041] lines 17-30) from a text-to-speech transcoder (i.e. audio channel on or off) that the selected advertisement has been delivered to the user client device in an audio format (Figure 3 | 0032).

39> Wu is silent on means for storing information associated with delivery of the advertisement to the user client device.

In the same field of invention, Logan discloses interactive advertisements and storing information associated with delivery of the advertisement to the user client device [column 27 «line 58» to column 28 «line 65» where the server stores information about how the user played the advertisement such as volume and whether any ads were skipped]. It would have been obvious to one of ordinary skill in the art to incorporate Logan's advertisement tracking

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functionality into Wu's advertising system to benefit the companies by providing useful information to better target and utilize their advertisements [see Logan, column 28 «lines 42-57»].

40> In regards to claim 58, Wu does not disclose storing information associated with user interaction. Logan discloses storing information associated with user interaction with the advertisement [column 22 «lines 20-25» | column 28 «lines 6-65»].

41> In regards to claim 59 Wu discloses the advertisement server of claim 57, further comprising means for providing additional information associated with the advertisement to the user client device in response to user interaction with the advertisement ([0027] lines 12 - 24, [0041] lines 6-20).

42> As to claims 60 and 61, Wu does not expressly disclose retrieving advertisements having a format and size compatible with the user requested content or the advertisements having a predetermined time length.

43> As to claim 60, Logan discloses wherein means for selecting advertisements for insert within user-requested Web content comprises means for retrieving advertisements having a format and size compatible with user-requested Web content when the web content is converted to an audio format [Figure 4 | column 18 «lines 21-45» | column 25 lines 35-50 where : Logan discloses the advertisements are inserted into a schedule table with the regular

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content, the advertisements in audio format like the requested content. The table ensures that the advertisements are of "compatible" size with the content as well].

As to claim 61, Logan discloses retrieving an advertisement having a predetermined time length when delivered in an audio format [Figure 4 | column 18 «lines 21-45» | column 23 «lines 40-45» | column 24 «lines 9-31» | column 25 lines 35-50 | column 34 «lines 24-44» where : the advertisement is defined as a segment of content].

It would have been obvious to one of ordinary skill in the art to incorporate Logan's advertisement scheduling functionality into Dames' system to insure that advertisements (content) inserted into content are compatible with the web content. Ensuring compatibility is both desirable and advantageous to the user and the content provider.

44> In regards to claim 62, Wu discloses the advertisement server of claim 57, wherein the text-based format comprises voice extensible markup language (VXML) format ([0028] lines 11-17).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dimitriadis et al, U.S Patent No. 5,664,948;

Logan et al, U.S Patent No. 5,732,216;

Trader et al, U.S Patent No. 5,832,432;

Ladd et al, U.S Patent No. 6,269,336;

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Christopoulos et al, U.S Patent Publication No. 2001|0047517;

Kurganov, U.S Patent Publication No. 2001|0054085;

Herrmann et al, U.S Patent No. 6.335.928;

Wang et al, U.S Patent Publication No. 2002|0003547;

Wesemann et al, U.S Patent No. 6.349.132;

Sarukkai, U.S Patent No. 2002|0052747;

Saylor et al, U.S Patent No. 6.501.832;

Wolfe et al, U.S Patent No. 6.507.817;

Scopes, U.S Patent No. 6.728.934;

Saylor et al, U.S Patent No. 6.792.086;

Partovi et al, U.S Patent No. 6.807.574;

Chen, U.S Patent No. 6.836.792;

Partovi et al, U.S Patent No. 6.842.767;

Wu, U.S Patent No. 6.874.018;

Loghmani et al, U.S Patent No. 6.941.273;

Partovi et al, U.S Patent No. 6.970.915;

Summers et al, U.S Patent No. 7.116.765;

Guerra et al, U.S Patent No. 7.174.297.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is 571.272.3942.

The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DC

A handwritten signature in black ink, consisting of a stylized 'B' followed by a series of loops and a long horizontal stroke.

BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER

5/24/07